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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,998	12/30/2003	Brian Becker	12055.3US01	5504

7590 03/28/2007  
Merchant & Gould P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903

EXAMINER
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LAUX, JESSICA L

ART UNIT	PAPER NUMBER
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3635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/750,998	BECKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jessica Laux	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 33-57 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 41-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 33-34, 51-57 is/are rejected.
- 7) ☒ Claim(s) 11, 35-36, 47-50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 13, 41-46 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 08/30/2006.

### ***Response to Arguments***

Applicant's arguments filed 01/08/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the fastening clip of Schaffert is not capable of being secured to a mounting track and further that the clip of Schaffert is designed to fixedly hold sheet metal deck member to purlins and therefore not capable of slidingly engaging a stud wall; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant has not provided remarks to clearly and convincingly show how the claimed invention results in a structural difference from the prior art.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references (i.e. Applicant has merely stated the structural features of the application and

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the structural features of the reference used in the rejection without a clear and convincing explanation of how the claims distinguish over the prior art. It is noted that although the reference discloses a clip with structural features having different names and disclosed uses, the clip/fastener of the reference is still capable of applicant's claimed use and clearly anticipates the structural features of applicant's fastener as recited in the claims).

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made (i.e. Applicant has not clearly and convincingly pointed out how the claims distinguish over the disclosed art, rather applicant has merely stated how the disclosed invention distinguishes from the prior art used in the rejection, without clearly referencing the claimed features).

An examination of the claims is presented below.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, 12, 33-34, and 51-57 are rejected under 35 U.S.C. 102(b) as being anticipated by A.H. Schaffert (1801240).

Regarding claim 1-4, 33 and 37: Schaffert discloses a wall fastener (capable for use between a stud wall and a mounting track, and configured to support first and second wall cladding material members relative to each other to provide a continuous wall cladding material structure between the stud wall and the mounting track, the

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mounting track having side walls with an inside surface and an outside surface), the fastener comprising:

a first portion (16) having first and second opposed primary surfaces and first and second sides the first portion capable of being secured to the mounting track with the first primary surface facing the mounting track and the second primary surface facing the first wall cladding material member;

a second portion (19, at the end after the curved portion) having a third primary surface that extends parallel to the first portion and is offset from the second primary surface a predetermined distance, (the second portion capable of being secured to the second wall cladding material member with the third primary surface facing the second wall cladding material member thereby supporting the second wall cladding material member in engagement with the first wall cladding material member); and

a first fastening structure (17) secured to the first side of the first portion, (where the first fastening structure is capable of slidingly engaging the stud wall thereby retaining the wall fastener to the stud wall while providing sliding movement of the wall fastener relative to the stud wall). Claims 2-4 contain functional limitation language that the structure of Schaffert is fully capable of; namely the structure is capable of the limitations: wherein the first wall cladding material member is secured to the stud wall and not secured to the wall fastener, and the second wall cladding material member is secured only to the second portion; wherein the primary wall member is secured to the plurality of studs, and the first portion is movably positioned between the primary wall member and one of the studs; and wherein the secondary wall member is secured to

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the second portion so as to be overlapping with the primary wall member and movable relative to the primary wall member.

Regarding claims 5 and 54: The wall fastener of claim 1, wherein the first portion includes an aperture (near 18) formed therein, the aperture being sized to receive a fastener for securing the first portion to the mounting track.

Regarding claims 6 and 39: The wall fastener of claim 2, wherein the first fastening structure includes a wrap around structure (Figure 3 and Col. 1, line 50 - Col. 2, line 1) configured to engage a flange of the stud.

Regarding claims 7-9, 38 and 40: The wall fastener of claims 1 and 37, further comprising a second fastening (17, on the other side) structure, having a wrap around structure, secured to the second side of the first portion, the second fastening structure being configured to slidably engage the stud wall thereby retaining the wall fastener to the stud wall while providing sliding movement of the wall fastener relative to the wall. Claims 8-9 include functional language limitations of which the structure of Schaffert is capable, namely: wherein the stud wall includes a stud that includes first and second sides, and the first fastening structure is configured to engage the first side of the stud and the second fastening structure is configured to engage the second side of the stud and wherein the stud wall includes a stud having a thickness measured in a direction perpendicular to a plane defined by the first primary surface, and the first portion of the fastener has a width greater than the thickness of the stud, whereby the first portion is secured to the mounting track at a location on the first portion offset from alignment with the stud.

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Regarding claims 10 and 34: The wall fastener of claims 1 and 33, further comprising a third portion (the round portion of 19) extending between the first and second portions to secure the first and second portions together.

Regarding claims 12 and 57: The wall fastener of claim 1, wherein the wall fastener comprises a single unitary piece of material (Col. 1, lines 47-48).

Regarding claims 51-53 and 55-56: These claims recite functional limitations, which merely requires the prior art be capable of. In the instant case the claimed limitations are anticipated by the structure of Schaffert since the structure of claims 34 and 38 above are capable of, namely: wherein the first wall cladding material member is secured to the stud wall and not secured to the wall fastener and the second wall cladding material member is secured only to the second portion; wherein the primary wall member is secured to the plurality of studs, and the first portion is movably positioned between the primary wall member and one of the studs; where in the secondary wall member is secured to the second portion so as to be overlapping with the primary wall member and movable relative to the primary wall member; wherein the stud wall includes a stud that includes first and second sides, and the first fastening structure is configured to engage the first side of the stud and the second fastening structure is configured to engage the second side of the stud; and wherein the stud wall includes a stud having a thickness measured in a direction perpendicular to a plane defined by the first primary surface, and the first portion of the fastener has a width greater than the thickness of the stud, whereby the first portion is secured to the mounting track at a location on the first portion offset from alignment with the stud.

***Allowable Subject Matter***

Claims 11, 35-36 and 47-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or suggest, nor provide any reason or motivation to combine references to obtain, a wall fastener of the structure as indicated above, having a fourth portion extending from the second portion toward the first portion and in the same plane as the first surface.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-



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8228. The examiner can normally be reached on Monday thru Friday, 6:30am to 2:30pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JL  
03/19/2007

  
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